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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,856	06/13/2001	Susan M. Duncan	ADAP-1-1002	8532

25315 7590 06/19/2002

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SEATTLE, WA 98104

EXAMINER

REIS, TRAVIS M

ART UNIT	PAPER NUMBER
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2859

DATE MAILED: 06/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/881,856

Applicant(s)

DUNCAN, SUSAN M. *MC*

Examiner

Travis M Reis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 23 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3. 6) ☐ Other: ____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-22, drawn to a design tool, classified in class 33, subclass 1G.
 - II. Claims 23-24, drawn to display packaging, classified in class D09, subclass 414.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and that the subcombination has utility by itself or in other combinations. In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the display packaging may be used with a different design tool such as one which does not require a second surface engaged with the design plans to display a different product besides an icon. The subcombination has separate utility such for as designing a table in design plans to accommodate the figure.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with David Lowe on 6/5/02 a provisional election was made with traverse to prosecute the invention of a design tool, claims 1-22. Affirmation of this election must be made by applicant in replying to this Office action.

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Claims 23 & 24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Information Disclosure Statement

5. The information disclosure statement filed 1-31-01 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Drawings

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 36, 78. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

7. Claim 4 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 3/1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

8. Claims 21 & 22 are objected to under 37 CFR 1.75 as being substantial duplicates of claim 1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 6, 21, & 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Arai et al. (JP03168685).

Arai et al. disclose a design tool for use in association with design plans having hallways, doorways, stairways, rooms and other spaces of a known scale, for functional and space planning in the fields of architecture, interior design, and construction of residential and commercial structures, comprising a base (13) having a first surface and a second surface, the second surface engagable with the design plans, the base scaled to indicate a turning radius to imitate the turning radius of a support device used by persons with disabilities and the aging population, and an icon figure (4k) attached to the first surface of the base, the icon figure sized to the scale of the design plans to allow accurate representation of the movement of persons with disabilities and the aging population along the hallways, doorways, stairways, rooms and other spaces of

the design plan to visually illustrate the feasibility of movement along the noted paths in light of the size and turning radius of the represented person (Figure 9).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2 & 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arai et al.

Arai et al. disclose all of the instant claimed invention as stated above in the rejection of claims 1, 6, 21, & 22 but do not disclose expressly the icon is shaped as a human seated in a wheelchair.

The shape of the icon, absent any criticality, is only considered to be obvious modifications of the shape of the icon disclosed by Arai et al. as the courts have held that a change in shape or configuration, without any criticality, is within the level of skill in the art as the particular shape claimed by Applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide using routine experimentation based on its suitability for the intended use of the invention. See *In re Dailey*, 149 USPQ 47 (CCPA 1976). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to shape the icon disclosed by Arai et al. into a human in a wheelchair form in order that a design plan could be modeled on whether it was wheelchair accessible.

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13. Claims 3-5, 7-10, 14-17, & 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arai et al. as applied to claims 1, 2, 6, 13, 21, & 22 above, and further in view of Hylander (U.S. Patent 1973900).

With reference to claims 3-5, 7-9, 14-16, & 20 Arai et al. disclose all of the instant claimed invention as stated above in the rejection of claims 1, 2, 6, 13, 21, & 22 but does not disclose expressly a wand extending from and supporting the member in operation of the design tool, the wand having a first end and a second end.

Hylander discloses a traffic position indicating model which uses wands (32), with openings (27) from which the wands depend, having upper ends and bases (33), maintained by frictional contact, in the form of a nut and threaded end, extending from the tops of the model cars (24) (Figures 2, 8, & 9). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to add the wand disclosed by Hylander to the icon disclosed by Arai et al. in order that the icon may be easier to pick up and/or move around on top of design plans.

With reference to claims 10 & 17, Arai et al. & Hylander disclose all of the instant claimed invention as stated above in the rejection of claims 3-5, 7-9, 14-16, & 20 including the icon figure having a metal plate/being composed of magnetic material, thereby, being located the base of the opening (Abstract).

Arai et al. & Hylander do not disclose expressly the first end of the wand includes a magnet, and the wand is maintained within the opening of the icon figure by the metal place-magnet combination. Official notice is taken with respect to the wand including a magnet in order that it may be fastened to the icon since it is very well known in the art

to use a magnet as fastening means between two objects. Thus, to include a magnet to fasten the icon to the wand disclosed by Arai et al. & Hylander would have been obvious to a person having ordinary skill in the art at the time the invention was made since the icon is already magnetic. Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to replace the fastening means taught by Arai et al. & Hylander with a magnet in the first part of the wand in order that the wand be releasably connectable to the icon.

14. Claims 11, 18, & 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arai et al. & Hylander as applied to claims 3-5, 7-9, 14-16, & 20 above, and further in view of Lam (U.S. Patent 6190174).

With reference to claims 11 & 18, Arai et al. & Hylander teach all of the instant claimed invention as stated above in the rejection of claims 3-5, 7-9, 14-16, & 20 and including fastening means comprising a nut and threaded member.

Arai et al. & Hylander do not disclose expressly the opening of the icon figure includes first ridge members along the interior of the opening, the first end of the wand includes second ridge members corresponding to the first ridge members along the interior of the opening, and the wand is maintained within the opening of the icon figure by the snap-lock combination between the first and second ridge members.

Lam discloses an electronic story board with a model (26) and including snap-lock means using tabs to fit into holes (46, 48) into order to securely snap-lock into place (Figure 1). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to replace the fastening means taught by Arai

et al. & Hylander with the snap-lock means disclosed by Lam in order that the wand be releasably connectable to the icon.

With reference to claim 19, Arai et al. & Hylander teach all of the instant claimed invention as stated above in the rejection of claims 3-5, 7-9, 14-16, & 20 but do not disclose expressly the base having a diameter equal to or greater than the diameter of the icon figure.

Lam discloses an icon (20) with a base which is equal to the diameter of the icon figure. Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to replace the base taught by Arai et al. & Hylander with the base disclosed by Lam in order that the icon will better stand upright.

15. Claims 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arai et al. as applied to claims 1, 6, 21, & 22 above, and further in view of Lam.

Arai et al. disclose all of the instant claimed invention as stated above in the rejection of claims 1, 6, 21, & 22 but do not disclose expressly the base has a diameter equal to or greater than the diameter of the icon figure.

Lam discloses an icon (20) with a base which is equal to the diameter of the icon figure. Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to replace the base taught by Arai et al. with the base disclosed by Lam in order that the icon will better stand upright.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Copen et al. disclose a kit and method for demonstrating

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courtroom and trial procedure (U.S. Patent 5201660). Wright discloses a modular furniture design aid (U.S. Patent 4626218). Riehle discloses a floor planning aid using transparent foil. (U.S. Patent 4250642). Miller discloses a room planning kit (U.S. Patent 4017986). Favreau discloses a model for illustrating office buildings and the like (U.S. Patent 1873748). Marshall discloses means for investigating street occurrences (U.S. Patent 1625041). Arai et al disclose a method for planning the disposition of a building (JP 3168682A).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis M Reis whose telephone number is (703) 305-4771. The examiner can normally be reached on 8:00--5:00 Monday--Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on (703) 308-3875. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Travis M Reis
Examiner
Art Unit 2859



Diego Gutierrez
Supervisory Patent Examiner
Technology Center 2800

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June 17, 2002